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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,912	02/11/2004	Milo S. Medin	19675-08643	6075
758	7590	03/14/2005	EXAMINER	
FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			NEURAUTER, GEORGE C	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/777,912

Applicant(s)

MEDIN, MILO S.

Examiner

George C. Neurauter, Jr.

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claims 1-3 are currently presented and have been examined.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3 are rejected under the judicially created doctrine of obviousness-type double patenting as being

Art Unit: 2143

unpatentable over claims 11-17 of U.S. Patent No. 6 370 571.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim 1 of the instant application and claim 11 of Patent 6 370 571 recite assigning general content to be multicast to a multicast destination address, customizing the general content to suit a first and second area which forms a first and second version of the content and multicasting the first and second versions to end-user systems in the first and second areas or "providing regionally-customized multicast content to a group of...end-user systems" as recited in claim 11 of US Patent 6 370 571.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6 101 180 to Donahue et al.

Art Unit: 2143

Regarding claim 1, Donahue discloses a method for delivery of high-performance online multimedia services comprising:

assigning general content to be multicast to a multicast destination address; (column 8, lines 7-25)

customizing the general content to suit a first area and thus forming a first version of the content; customizing the general content to suit a second area and thus forming a second version of the content; multicasting the first version to an end-user system in the first area; and multicasting the second version to an end-user system in the second area. (column 5, lines 27-45, specifically lines 30-32 and 37-40; column 5, lines 55-58)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for

Art Unit: 2143

establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donahue in view of "Cable Modem Termination System - Network Side Interface Specification ("CTMS-NSIS").

Regarding claim 2, Donahue discloses the method of claim 1.

Donahue does not expressly disclose wherein the first area corresponds to a region served by a first regional data center, and the second area corresponds to a region served by a second regional data center, however, "CTMS-NSIS" discloses these limitations (page 3, "Cable Modem Termination System", specifically "distribution hub")

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since "CTMS-NSIS" discloses that the regional data centers allow data to sent over coaxial networks (page 1, "1. Scope and Purpose", first paragraph) and implements multicasting of data to specific end users (page 6, "IP multicast addressing and forwarding"). In view of these specific

Art Unit: 2143

advantages and that the references are directed to multicasting of data to end users, one of ordinary skill would have been motivated to combine these references and would have considered them to be analogous to one another based on their related fields of endeavor.

Regarding claim 3, Donahue discloses the method of claim 2.

Donahue does not disclose wherein the first area corresponds to a locality served by a first modified head-end, and the second area corresponds to a locality served by a second modified head-end, however, "CTMS-NSIS" discloses these limitations (page 3, "Hybrid Fiber/Coax (HFC) System", specifically "fiber node")

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since "CTMS-NSIS" discloses that the modified head ends allow data to sent over coaxial networks (page 1, "1. Scope and Purpose", first paragraph) and implements multicasting of data to specific end users (page 6, "IP multicast addressing and forwarding"). In view of these specific advantages and that the references are directed to multicasting of data to end users, one of ordinary skill would have been motivated to combine these references and would have considered

Art Unit: 2143

them to be analogous to one another based on their related fields of endeavor.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following prior art teaches the state of the art in delivery of high performance online multimedia services, including delivering customized content to a specific area (local or targeted advertising):

US Patent 5 446 490 to Blahut et al;

US Patent 6 745 837 to Fuhrmann;

US Patent 5 790 541 to Patrick et al;

US Patent 5 847 751 to Safadi;

US Patent 6 738 978 to Hendricks et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is (571) 272-3918. The examiner can normally be reached on Monday through Friday from 9AM to 5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the

Art Unit: 2143

organization where this application or proceeding is assigned is
703-872-9306.

Information regarding the status of an application may be
obtained from the Patent Application Information Retrieval
(PAIR) system. Status information for published applications
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access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

gcn

Will C. Vaughn
Primary Examiner
Art Unit 2143
William C. Vaughn, Jr.